



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/625,863

07/22/2003

Bruce A. Phillips

020366-091300US

7985

20350 7590 06/26/2007
TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

SCHEIBEL, ROBERT C

ART UNIT

PAPER NUMBER

2616

MAIL DATE

DELIVERY MODE

06/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/625,863

Applicant(s)

PHILLIPS ET AL.

Examiner

Robert C. Scheibel

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 17 is objected to because of the following informalities:
 - The phrase “an incoming phone call” should be changed to either (1) “the incoming phone call” if it is the same phone call of lines 3 and 4 or (2) “a second incoming phone call” if Applicant intends a distinct phone call.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 16 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 16 and 22 are single-means claims as they cover every conceivable system for implementing the claimed method, but the specification only discloses those systems known to the inventor. As such, these claims are not enabling. See “Section 2164.08(a) Single Means Claim” of the Manual of Patent Examination Procedure (MPEP) for more information.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 8, and 10-22 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 7,162,020 to Forte.

Regarding claim 1, Forte discloses a telephonic communication system for integrating wireless phone service with home phone service, the telephonic communication system comprising: a first communication channel to a wireless phone (the link from the Wireless Connect 30 to the cellular phone 70 of Figures 1 and 3); a second communication channel to an interface coupled to one or more wired phones at a user location (the link from the Wireless Connect 30 to telephones 12a and 12b of Figures 1 and 3), wherein the first and second communication channels are accessible with a telephone number (the single telephone number described throughout; see the first 3 lines of the abstract as one example); and a telephone switch coupled to the first and second communication channels (the combination of the PBX 14 and Wireless Connect 30 of Figures 1 and 3), wherein the telephone switch determines if the first and second communication channels should be simultaneously sent an incoming phone call directed to the telephone number (see lines 46-49 of column 13).

Similarly, regarding claim 10, Forte discloses a method for integrating wireless phone service with home phone service, the method comprising steps of: routing an incoming phone

Art Unit: 2616

call to a wireless phone (see step 410 of figure 4); routing the incoming phone call to a wireless interface coupled to one or more wired phones at a user location (step 402 of figure 4 and lines 39-45 of column 8; lines 23-31 of column 12 clearly indicate that the link between the PSTN and the PBX can be wireless), wherein the wireless phone and the one or more wired phones are accessible with a telephone number (the single telephone number described throughout; see the first 3 lines of the abstract as one example); determining if the wireless phone should be sent an incoming phone call (this is described throughout the document; consider the passage from line 67 of column 2 through line 3 of column 3); and determining if the one or more wired phones should be sent the incoming phone call (this is described throughout the document; consider the passage from line 67 of column 2 through line 3 of column 3).

Similarly, regarding claim 17, Forte discloses a method for integrating wireless phone service with home phone service, the method comprising steps of: routing an incoming phone call to a wireless phone (see step 410 of figure 4); routing the incoming phone call to an interface coupled to one or more wired phones at a user location (step 402 of figure 4 and lines 39-45 of column 8), wherein: the wireless phone and the one or more wired phones are accessible with a telephone number (the single telephone number described throughout; see the first 3 lines of the abstract as one example), and the first and second-listed routing steps are performed, at least partially, simultaneously (see lines 46-49 of column 13); determining if the wireless phone should be sent an incoming phone call (this is described throughout the document; consider the passage from line 67 of column 2 through line 3 of column 3); and determining if the one or more wired phones should be sent the incoming phone call (this is

Art Unit: 2616

described throughout the document; consider the passage from line 67 of column 2 through line 3 of column 3).

Regarding claim 2, Forte discloses the limitation that the wireless phone and the wireless interface uses one of GSM, CDMA, AMPS, and TDMA transport (see lines 22-25 of column 5).

Regarding claim 3, Forte discloses the limitation that the interface is located at the user location in that the WC and PBX are preferably co-located (see lines 51-55 of column 11) and the PBX is clearly at the user location (where phones 12a and 12b are located).

Regarding claim 4, Forte discloses the limitation that the telephone switch provisionally sends the incoming phone call to both the first and second communication channel until acceptance of the incoming phone call when one of the first and second communication channels receives the incoming phone call and the other of the first and second communication channel is disconnected from the incoming phone call (see steps 414-420 of Figure 4).

Regarding claim 8, Forte discloses the limitation that the first communication channel uses different physical transport within the user location from the second communication channel (see figure 1 which clearly shows a different interface between WC and the PBX and wireless phone).

Regarding claim 9, Forte discloses the limitation that the one or more wired phones are chosen from the group consisting of a POTS phone, a cordless phone, a WIFI TM SIP phone, and a wired SIP phone in that the analog telephone 12b is chosen from this group as it is a POTS phone.

Regarding claim 11, Forte discloses the limitation that the first and second-listed routing steps are performed, at least partially, simultaneously (see lines 46-49 of column 13).

Art Unit: 2616

Regarding claims **12 and 19**, Forte discloses the limitation that the first-listed determining step comprises a step of detecting if the one or more wired phones have been answered (see step 418 of Figure 4).

Regarding claims **13 and 20**, Forte discloses the limitation that the second-listed determining step comprises a step of detecting if the one or more wireless phones have been answered (see step 414 of Figure 4).

Regarding claim **14**, Forte discloses the limitation that the one or more wireless phones and the wired phones use a unified voice mailbox (see lines 64-67 of column 2).

Regarding claim **15**, Forte discloses the limitation of a computer-readable medium having computer-executable instructions for performing the computer-implementable method for integrating wireless phone service with home phone service of claim 10 in that all the limitations of the method are disclosed as above and the passage from line 66 of column 5 through line 10 of column 6 clearly suggests that this can be implemented using software.

Similarly, regarding claim **16**, Forte discloses a computer system adapted to perform the computer-implementable method for integrating wireless phone service with home phone service of claim 10 in that all the limitations of the method are disclosed as above and the passage from line 66 of column 5 through line 10 of column 6 clearly suggests that this can be implemented using software.

Regarding claim **18**, Forte discloses the limitation that the interface wirelessly couples the one or more wired phones to a phone call transport network in lines 23-31 of column 12 which indicate that the link between the PSTN and the PBX can be wireless.

Art Unit: 2616

Regarding claim 21, Forte discloses the limitation of a computer-readable medium having computer-executable instructions for performing the computer-implementable method for integrating wireless phone service with home phone service of claim 17 in that all the limitations of the method are disclosed as above and the passage from line 66 of column 5 through line 10 of column 6 clearly suggests that this can be implemented using software.

Similarly, regarding claim 22, Forte discloses a computer system adapted to perform the computer-implementable method for integrating wireless phone service with home phone service of claim 17 in that all the limitations of the method are disclosed as above and the passage from line 66 of column 5 through line 10 of column 6 clearly suggests that this can be implemented using software.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

Art Unit: 2616

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 7,162,020 to Forte in view of U.S. Patent Application Publication 2004/0170268 to Hokusui.

Regarding claim 5, Forte discloses all limitations of parent claim 1 as discussed above in the rejection under 35 U.S.C. 102(e). Forte also discloses that one of the advantages of the invention is the ability to provide the features of the PBX network to the remote device (see lines 64-67 of column 2, for example.) Forte does not disclose expressly the limitations of claim 5 that the second communication channel can join the incoming phone call of the first communication channel, and the phone call can be manually transferred from the second Communication channel to the first communication channel. However, it is well known that call transfer and conferencing are features of PBX systems. For example, Hokusui discloses this in paragraph 3 on page 1. Forte and Hokusui are analogous art because they are from the same field of endeavor of communication systems and similarly deal with simultaneously alerting multiple devices based on a single telephone number. At the time of the invention it would have been obvious to a person of ordinary skill in the art to *explicitly* include call transfer and conferencing in the features provided in the PBX of Forte and thus extended to the remote device to disclose the limitations of claim 5. The motivation for doing so would have been to allow flexibility generally provided in PBX systems to extend to the remote device as suggested by Forte in lines 61-67 of column 2. Therefore, it would have been obvious to combine Hokusui with Forte for the benefit of providing PBX features to the remote device to obtain the invention as specified in claim 5.

Art Unit: 2616

Regarding claim 6, Forte discloses all limitations of parent claim 1 as discussed above in the rejection under 35 U.S.C. 102(e). Forte does not disclose expressly the limitation of claim 6 that the interface is one of a wireless cellular interface, a PSTN interface and a VOIP interface. However, Hokusui discloses the limitation that the interface is one of a wireless cellular interface, a PSTN interface and a VOIP interface in the LAN interface to the virtual PBX of Figure 6. Forte and Hokusui are analogous art because they are from the same field of endeavor of communication systems and similarly deal with simultaneously alerting multiple devices based on a single telephone number. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the PBX implementation of Forte to include a LAN interface. The motivation for doing so would have been to reduce long distance charges as suggested by Hokusui in paragraph 4 on page 1. Therefore, it would have been obvious to combine Hokusui with Forte for the benefit of reducing long distance charges to obtain the invention as specified in claim 6.

Regarding claim 7, Forte discloses the limitation that the VOIP interface is one of a wireless Internet interface, a WIFI TM interface, a power line Internet interface, an ultra-wide band wireless interface, a microwave internet interface, a cable modem interface, and a direct broadcast Satellite Internet interface in lines 23-31 of column 12 which indicate that the link between the PSTN and the PBX can be wireless. In the above combination, where the PBX is connected to a LAN using VOIP, this interface will be a wireless Internet interface which discloses the limitation that the VOIP interface is a wireless Internet interface.

Conclusion

Art Unit: 2616

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. Patent 7,190,969 to Oh et al discloses a method for controlling service to multiple mobile stations having a common subscriber identifier.
- U.S. Patent 7,145,899 to Pearce et al discloses a method for providing shared line appearances in a distributed call routing network.
- U.S. Patent 6,694,004 to Knoerle et al discloses a system for simultaneous ring service.
- U.S. Patent 6,895,002 to Shah et al discloses a method to provide a single telephone number for geographically dispersed subscribers.
- U.S. Patent 6,816,582 to Levine et al discloses a method automatically simultaneously ringing alternative telephone numbers.
- U.S. Patent 6,697,478 to Meldrum et al discloses a method for simultaneous telephone ringing.
- U.S. Patent Application 2003/0125072 to Dent discloses a method of providing multiple mobile telephones with the same telephone number.
- U.S. Patent 6,449,483 to Akhteruzzaman et al discloses a wireless telephone system for accessing multiple stations via a single telephone number.
- U.S. Patent 6,798,767 to Alexander et al discloses a system for generating multiple line appearances in a communication network.

Art Unit: 2616

- U.S. Patent 5,454,032 to Pinard et al discloses a method of establishing a communication link to one of multiple devices associated with a single telephone number.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Scheibel whose telephone number is 571-272-3169. The examiner can normally be reached on Monday and Thursday from 6:30-5:00 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing F. Chan can be reached on 571-272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RCS 6-25-07
Robert C. Scheibel
Patent Examiner
Art Unit 2616

Wing F. Chan
6/25/07
WING CHAN
SUPERVISORY PATENT EXAMINER